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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,440	12/03/2003	Yuji Okada	2003_1725A	5356

513 7590 01/20/2006

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,440

Applicant(s)

OKADA, YUJI

Examiner

Robert Sellers

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of epoxy resin since 3,4-epoxycyclohexymethyl 3'4'-epoxycyclohexanecarboxylate has been elected; there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 12, 2005.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

1. The claimed hardening agent is broader than the enabling disclosure. Page 19, line 25 to page 20, line 8 only describes acid anhydride hardening agents. Examples 1 and 2 on pages 24 and 27 and Polymerization Examples 1-10 of Table 1 on page 32 utilizes solely methylhexahydrophthalic anhydride MH700. Page 1, lines 24-25 states that only the acid anhydrides provide the desired minimal discoloration and translucency. More favorable consideration would be given to the limitation of the claims to an acid anhydride hardening agent.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogata et al. Patent No. 3,637,572 further illuminated by CAPLUS accession no. 1971:43048 (the abstract for the patent).

2. Ogata et al. shows a mixture of 100 parts by weight of an epoxy resin, methylenedimethylene-tetrahydrophthalic anhydride and 1 part by weight of p-(xylenebis(triphenylphosphonium tetraphenyl borate) conforming to claimed formula (I) wherein one of R^1 , R^2 , R^3 and R^4 is $-\text{CH}_2\text{-phenyl-CH}_2\text{-P}^+\text{Ph}_3$ (see registry no. 31586-93-3 in CAPLUS accession no. 1971:43048). The radical $-\text{CH}_2\text{-phenyl-CH}_2\text{-P}^+\text{Ph}_3$ conforms to formula (II) wherein R^8 , R^9 , R^{10} and R^{11} are hydrogen, A is a phenyl group $n = 1$ and $m = 1$ and R^5 , R^6 and R^7 are phenyl groups.
3. The formula for p-(xylenebis(triphenylphosphonium tetraphenyl borate) is the same as that employed in the specification on page 32, Table 1, Polymerization Example 5 as corroborated by a comparison between the formula for the catalyst and registry no. 31586-93-3. The p-(xylenebis(triphenylphosphonium tetraphenyl borate) is within the ambit of phosphonium compound (a) of claim 2.
4. The mixture forms a hardened product as confirmed by the gelation data reported in Table 1. The elected species of methylhexahydrophthalic anhydride is set forth in column 3, lines 21-22.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. Japanese Patent No. 8-34834 is directed to a composition comprising an epoxy resin, a phenolic resin and a bis(triorganophosphonium) salt wherein the organic anion is a benzoate, a triazine or a benzotriazole (CAPLUS accession no. 1996:248317, page 2, first IT; and the translation, page 2, paragraph 11) which is precluded from the claimed anion X^- of SbF_6 , AsF_6 , PF_6 , BF_4 or BPh_4 .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712